

REMARKS

Claims 14-47 are pending in the present application. Per this Amendment, claims 32-36 have been canceled.

The Examiner is thanked for the courtesies extended during the personal Interview held with Applicant's representative. Below is a description of the substance of that Interview.

During the Interview, claims 15 and 37-43 were discussed. The claims recite, among other elements, the selection of one of the multiple output devices on the basis of the location information, and sending of an e-mail to the portable unit that contains notification of the selected image output device. After discussing the subject matter of claim 15, the Examiner acknowledged the combination of these claimed features had not been considered, and that the applied prior art does not teach such a combination of features.

With regard to claims 14 and 31, although the Examiner appreciated Applicant's arguments, there was no agreement as to whether claims 14 and 31 were not disclosed by the Miller patent.

In the present Office Action, claims 40-43 have been rejected under 35 U.S.C. §101 and §112, first paragraph. In making the rejections of claims 40-43 under 35 U.S.C. §101, paragraph 8 of the rejection states to overcome this type of §101 rejection, the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. However, claim 40 recites "a computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of..." (emphasis

added). It is unclear to the Applicant how the Examiner is interpreting this language to recite anything other than a physical medium. In addition, Applicant's specification in paragraph [0137], last sentence, states that the program can be provided by computer-readable memory media such as flexible discs, CD-ROMS, optical magnetic disc, hard discs and RAMs. There is no mention of carrier waves or transmission medium. Applicant respectfully requests the Examiner to explain how the term "stored on" in combination with the disclosure in the specification can be read on a carrier medium or transmission medium.

Claims 40-43 have been rejected as not complying with the written description requirement of 35 U.S.C. §112, first paragraph. Applicant respectfully traverses. The claimed subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the description requirement. Software aspects of the invention may be described functionally. See *Robotic Vision Sys. v. View Eng'g, Inc.*, 112 F.3d 1163,1166, 42 USPQ2d, 1619,1622-23 (Fed. Cir. 1997). Applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565,1572, 41 USPQ2d 1961,1966 (Fed. Cir. 1997).

Furthermore, it is been held if a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claim does not explicitly describe in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935F.2d 1555,1563,19 USPQ2d 1111,1116 (Fed. Cir. 1991).

Applicant asserts when the specification is read as a whole, in particular, Figure 3 and the associated description in paragraphs [0044]-[0053] of Applicant's specification provides sufficient detail regarding Applicant's invention to meet the written description requirement of 35 U.S.C. §112, first paragraph.

Therefore, Applicant asserts that one of skill in the art upon reading Applicant's specification would understand Applicant had possession of the claimed invention at time of filing. Applicant respectfully submits that the specification complies with the written description requirement of 35 U.S.C. §112, first paragraph, and request that the rejection be withdrawn.

Applicant respectfully traverses the Examiner's rejection of claims 40-43 for not complying with the enablement requirement of 35 U.S.C. §112, first paragraph. A patent need not teach, and preferably admits what is well known in the art. The test for enablement is whether the experimentation needed to practice the invention is undue or unreasonable. (See MPEP §2164).

In the present specification, the claimed features of claim 40 are sufficiently described to provide one of ordinary skill in the art a reasonable basis upon which to make and use Applicant's claimed invention without undue experimentation.

Applicant respectfully submits that the enablement requirement of 35 U.S.C. §112, first paragraph has been met. If the Examiner intends to maintain this rejection, he is respectfully requested to provide the factual basis upon which he is relying to make the determination that the Applicant's specification does not meet the enablement requirement of 35 U.S.C. §112, first paragraph.

Claims 14-31 and 37-42 have been rejected under 35 U.S.C. §102(e) in view of Miller, U.S. Patent No. 6,421,707. Claims 32-36 have been rejected under 35

U.S.C. §102(e) in view of Theimer, U.S. Patent No. 5,493,692. Claims 14-46 have been rejected under 35 U.S.C. §103(a) in view of the combination of the Miller patent and the Theimer patent. Claim 47 has been rejected under 35 U.S.C. §103(a) in view of the combination of the teachings of the Miller and Theimer patents, further in view of Glorikian, U.S. Patent No. 6,343,317.

The rejection of claims 14, 31 and 44-46 over the Miller patent is made on pages 11-14 of the Office Action. The Office Action states on page 12 that the claimed feature of an "e-mail transmitting device transmitting to said portable terminal unit, the receipt e-mail prepared by said e-mail preparing device and an e-mail identifying multiple prospective image output devices" is disclosed at column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46 of the Miller patent.

As for the citation to column 1, lines 47-58 of the Miller patent, this section describes notifying a subscriber of receipt of a message, and selectively delivering a message to the subscriber. It does not state nor does it suggest that the subscriber is provided with an e-mail identifying multiple prospective output devices.

As for the citation of column 2, lines 58-64, it is directed to a description of the delivery system 160. The delivery system 160 includes interfaces to a variety of delivery systems including cellular/PCS short messaging service 161, public switched telephone network, voice/fax 162 and internet or other e-mail 163. The citation does not describe delivery of an e-mail identifying multiple prospective image output devices as recited in claim 14.

Column 5, lines 35-49 of the Miller patent discusses providing the content of an attachment in an e-mail to a user, and allowing the user to view the entire e-mail

in the main body of the e-mail, respectively, as well as the type and size of each attachment. The user can specify which part of the e-mail he wishes to retrieve by selecting that part of the e-mail using the keypad 413 as shown in Figure 4 (j). The user can specify the retrieval method, e.g., SMS, fax or voice. This cited section does not disclose or suggest an instruction receiving device receiving an e-mail including an instruction for specifying one of the image output devices.

As for the citation to column 6, lines 14-19, this merely states that the user enters a destination fax number to which the graphic file is to be sent in facsimile format. Upon transmission of the specified fax number, the service complex 101 of Miller patent sends the attachment to the appropriate converter in the converter bank 180, and then transmits it via delivery system 160. The transmission format of the specified fax number is not described and does not appear from Figure 4(r) of the Miller patent to be in an e-mail format identifying the multiple prospective image output devices as recited in the claim.

Finally, the citation to column 9, lines 40-46 describes the filtering and forwarding rules 715 as described in Figure 7 of the Miller patent. The filtering and forwarding rules 715 are pre-established by a service subscriber. The rules are flexible, and permit the filtering and forwarding of mail messages in any manner capable of being specified as a rule. This passage does not describe an e-mail identifying multiple prospective image output devices as recited in claim 14.

The above cited portions of the Miller patent do not disclose or suggest an e-mail transmitting device transmitting to said portable terminal unit the receipt notice e-mail prepared by said e-mail preparing device and an e-mail identifying multiple prospective image output devices as recited in claim 14.

As for claim 31 and 44-46, these claims are apparently rejected under the same rationale as claim 14. As described above, the Miller patent does not disclose or recite all of the features recited in independent claim 31. For instance, the features of an e-mail transmitting device transmitting to said portable terminal unit the receipt notice e-mail prepared by said e-mail preparing device and an e-mail identifying multiple prospective image output devices in combination with the other features recited in independent claim 31 are not disclosed or suggested by the Miller patent.

As for claim 44 and claims 45 and 46 that depend therefrom, the Miller patent does not disclose or suggest, at least, the step of generating at least one e-mail containing a notification of the receipt of the e-mail and information on at least one output device to which at least a part of the e-mail is to be outputted.

Accordingly, the rejection of claims 14, 31 and 44-46 over the Miller patent should be withdrawn.

As for claims 15, and 37-43, as discussed in the Examiner's Interview, claim 15 recites the selection of one of the multiple output devices on the basis of the location information and the sending of an e-mail to the portable unit that contains a notification of the selected image output device. During the interview the Examiner agreed that these features, in combination with the other features recited in the claim, were not disclosed or suggested by the applied prior art. Applicant respectfully requests that the rejection under 35 U.S.C. §102(e) of claims 15 and 37-43 over the Miller patent be withdrawn.

Claims 14-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the Miller patent with the Theimer patent.

In making the rejection on pages 16-20 of the Office Action, the Examiner appears to be paraphrasing the limitations of the independent claims. By doing so, the Examiner has failed to address, for instance, in claim 14, the feature of an instruction receiving device receiving an e-mail including an instruction for specifying one of multiple image output devices. As stated above, the Miller patent neither discloses nor suggests such a feature. The teachings of the Theimer patent do not overcome this deficiency in the teaching of the Miller patent. The system disclosed in the Theimer patent, as in the Miller patent, must rely on pre-established rules for determining delivery of the person of e-mailed device to a specified image output device. Therefore, the combination of the Miller and Theimer patent do not disclose all of the features recited in claim 14.

As for claim 15, the Theimer patent does not make up for the deficiencies of the Miller patent as disclosed above as agreed to by the Examiner. In addition, the Theimer patent does not disclose or suggest the feature of a notifying device that sends an e-mail to said portable terminal unit containing a notification of an image output device selected by said selecting device as recited in independent claim 15.

As for independent claim 31, the combination of the Miller and Theimer patents does not disclose or suggest, an e-mail identifying multiple prospective image output devices nor an instruction receiving device receiving an e-mail including an instruction specifying one of the multiple image output devices as recited in independent claim 31.

As for claim 37-40, neither the combination of the Miller patent and Theimer patent nor the patents individually disclose or suggest the feature of a notifying device that sends an e-mail to said portable terminal unit containing a notification of

the image output device selected by said selecting device or sending an e-mail to said destination containing a notification of the selected image output device as similarly recited in the respective claims.

Finally, as recited in dependent claim 45 the Miller and Theimer patents, either individually or in combination, do not disclose or suggest the feature of wherein upon receipt of an e-mail from the certain destination designating one of the multiple prospective image output devices, the processor sends said part of the e-mail to the designated image output device.

The Miller patent and the Theimer patent, either individually or in combination, fail to disclose or suggest all of the features recited in claims 14-46. Hence, the rejection of claims 14-46 over the combination of the Miller and Theimer patents should be withdrawn.

As for the Glorikian patent, which discloses delivering travel-related information to a user, it does not overcome the deficiencies of the Miller and the Theimer patents as discussed above. Therefore, claim 47 is allowable.

Applicants request withdrawal of the rejection of claims 14-31 and 37-47 and notification of allowance over the applied prior art.

Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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